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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,483	05/08/2001	Jack J. Johnson	113071.129-US1	3783
28089	7590	08/10/2010		
WILMERHALLE/NEW YORK			EXAMINER	
399 PARK AVENUE			OYEBISI, OJO O	
NEW YORK, NY 10022			ART UNIT	PAPER NUMBER
			3695	
			NOTIFICATION DATE	DELIVERY MODE
			08/10/2010	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JACK J. JOHNSON and  
WILLIAM F. COYLE

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Appeal 2009-011900  
Application 09/851,483  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and  
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

#### STATEMENT OF THE CASE

Jack J. Johnson, et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 46-51, 53-67, 69-71, 82-88, 90-103, 118-121, and 123. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

#### SUMMARY OF DECISION

We AFFIRM.<sup>2</sup>

#### THE INVENTION

Claim 46 is illustrative:

46. A method for creating a bidding process among telecommunication Providers in which a moderating computer collects bids from at least two telecommunication Providers, processes the bids and designates at least one Provider of the at least two telecommunication Providers to provide telecommunication service, wherein the method comprises:

- a. in the moderating computer, receiving bids to provide telecommunication service over at least one route, or at least one route segment, on at least one telecommunication network, processing the bids to produce processed bid data, and storing the bids and the processed bid data in a data base of the moderating computer as first bidding data;
- b. in the moderating computer, transmitting at least a portion of the first bidding data to at least a portion of the at least two telecommunication Providers;

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<sup>2</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br." filed Jun. 30, 2008) and Reply Brief ("Reply Br." filed Nov. 6, 2008), and the Examiner's Answer ("Answer," mailed Sep. 19, 2008).

- c. in the moderating computer, designating at least one Provider of the at least two telecommunication Providers as a first designated Provider to provide telecommunication service over at least one route, or at least one route segment, on at least one telecommunication network; and
- d. in a computer adjunct to at least one telecommunication switch, performing at least a portion of the processing or communications functions of the moderating computer.

### THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Taylor	US 5,790,642	Aug. 4, 1998
Harrington	US 6,161,099	Dec. 12, 2000

The following rejection is before us for review:

1. Claims 46-51, 53-67, 69-71, 82-88, 90-103, 118-121, and 123 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor and Harrington.

### ISSUE

The issue is whether claims 46-51, 53-67, 69-71, 82-88, 90-103, 118-121, and 123 are unpatentable under 35 U.S.C. § 103(a) over Taylor and Harrington. Specifically, the major issue is whether one of ordinary skill in the art would have been led by Taylor and Harrington to the steps of “processing the bids to produce processed bid data, and storing the bids and the processed bid data in a data base of the moderating computer as first bidding data” and “transmitting at least a portion of the first bidding data to at least a portion of the at least two telecommunication Providers” as recited

in claim 46. The rejection of claims 47-51, 53-67, 69-71, 82-88, 90-103, 118-121, and 123 also turn on this issue.

### FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. We adopt the Examiner's findings of fact as to the Taylor and Harrington references in the rejection of claim 46 on pages 3-6 of the Answer.
2. The Appellants have provided no evidence of secondary considerations or unexpected results.

### ANALYSIS

The Appellants argue claims 46-51, 53-67, 69-71, 82-88, 90-103, 118-121, and 123 as a group (App. Br. 10-15). We select claim 46 as the representative claim for this group, and the remaining claims 47-51, 53-67, 69-71, 82-88, 90-103, 118-121, and 123 stand or fall with claim 46. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

The Appellants argue: 1) that column 10, line 42-column 11, line 5 of Harrington does not disclose providing the claimed "first bidding data" to at least a portion of at least two telecommunication Providers' as asserted by the Examiner (App. Br. 12-13 and Reply Br. 3-4) and 2) that the Examiner has not provided proper reasoning to make the combination (App. Br. 13-15).

Turning to the Appellants' first argument, the Appellants argue that the combination of Taylor and Harrington fails to teach all of the limitations of claim 46, since 1) Harrington does not teach the transmission of first bidding data, which includes processed bid data as well as the received bid and 2) Harrington does not teach that the first bidding data is transmitted to telecommunication Providers. App. Br. 12-13.

The Appellants assert that since the claim defines the "first bidding data" as "a combination of the received bids and the processed bid data." (Reply Br. 3), and, therefore, the prior art must teach "the transmission of data that includes *received bids for telecommunication service*, as well as data resulting from *the processing of those bids*" (Reply Br. 4)(emphasis original). However, we see no such requirement in claim 46.

As the Appellants argue, claim 46 does recite "storing the bids and the processed bid data in a data base of the moderating computers as first bidding data." However, claim 46 only requires that *at least a portion* of the first bidding data be transmitted. Claim 46 recites "transmitting *at least a portion* of the first bidding data to at least a portion of the at least two telecommunication Providers." (Emphasis added.) Claim 46 does not recite any other restrictions on which portion of the first bidding data is transmitted and does not preclude transmitting a portion that only contains the received bids and not the processed bid data. The Appellants' argument is based on a limitation not required by claim 46. Accordingly, we are not persuaded by the Appellants' argument.

Next, the Appellants argue that in order for the combination of Taylor and Harrington to teach the claimed step of transmitting, Harrington must teach bidders that are telecommunication providers. App. Br. 13 and Reply

Br. 4. The Appellants assert that Harrington discloses bidders that are users of municipal bonds auction website instead of the telecommunication providers. Reply Br. 4.

As the Appellants argue Harrington does describe the bidders as municipal bond bidders instead of telecommunication providers. However, the issue is not whether Harrington anticipates claim 46 but whether claim 46 is unpatentable under 35 U.S.C. § 103 over Taylor and Harrington. The mere existence of differences between the prior art and the claim does not establish nonobviousness. *Dann v. Johnston*, 425 U.S. 219, 230 (1976). The issue is "whether the difference between the prior art and the subject matter in question 'is a difference sufficient to render the claimed subject matter unobvious to one skilled in the applicable art.'" *Dann*, 425 U.S. at 228-29, (citation omitted). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *KSR Int'l. v Teleflex, Inc.*, 550 U.S. 398, 417 (2007).

We note that, as the Examiner asserted (Answer 5), Taylor describes an auction system where the bidders are telecommunication providers. The Appellants do not challenge this assertion and fail to address whether the Examiner's proposed combination of Taylor and Harrington results in a step of transmitting a portion of the first bidding data to the recited telecommunication Provider. Accordingly, we are not persuaded by the Appellants' argument

Turning to the Appellants' second argument, the Appellants argue that the Examiner has not articulated a proper reasoning to support the obviousness rejection, including that the Examiner's rationale of "allowing the telecommunication service providers to correct the current proposed bid"

was taken from the Appellants' Specification and that, therefore, the Examiner improperly applied hindsight in finding the combination of Taylor and Harrington obvious. App. Br. 13-15. The Examiner responds that the asserted motivation for the combination is found in column 11, lines 1-5 of Harrington. Answer 19.

It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. So long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). Here, as asserted by the Examiner, Harrington's column 11, lines 1-5 teaches that allowing bidders to correct proposed bids was within the knowledge of one of ordinary skill in the art at the time of the claimed invention. Applying this knowledge to the auction in Taylor, where the bidders are telecommunication providers, would be nothing more than arranging old elements with each performing their same known function. “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR*, 550 U.S. at 417, (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, (1976)). We note that the Appellants do not argue or provided any evidence that the combination of Taylor and Harrington would yield more than would be expected. FF 2. Accordingly, we are not persuaded by the Appellants' argument.

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Accordingly, we find that the Appellants have not overcome the rejection of claims 46-51, 53-67, 69-71, 82-88, 90-103, 118-121, and 123 under 35 U.S.C. § 103(a) as being unpatentable over Taylor and Harrington.

#### DECISION

The decision of the Examiner to reject claims 46-51, 53-67, 69-71, 82-88, 90-103, 118-121, and 123 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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